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Michael J. Rojas

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* MICHAEL J. ROJAS  
9

10 Appeal 2008-1566  
11 Application 09/808,436  
12 Technology Center 3600  
13

14  
15 Decided: September 12, 2008  
16

17  
18 Before HUBERT C. LORIN, ANTON W. FETTING,  
19 and DAVID B. WALKER, *Administrative Patent Judges*.  
20 FETTING, *Administrative Patent Judge*.

21 DECISION ON APPEAL

22 STATEMENT OF CASE

23 Michael J. Rojas (Appellant) seeks review under 35 U.S.C. § 134 of a  
24 final rejection of claims 1-7, the only claims pending in the application on  
25 appeal.

26 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)  
27 (2002).

1       We AFFIRM and DENOMINATE AS A NEW GROUND OF  
2 REJECTION PURSUANT TO 37 C.F.R. § 41.50(b).

3  
4       The Appellant invented a way of cost accounting for data usage over a  
5 network and for web hosting applications for managing telecommunications  
6 devices. (Specification 1:17-19).

7       An understanding of the invention can be derived from a reading of  
8 exemplary claim 1, which is reproduced below.

- 9       1.     A method for cost accounting of data usage over a  
10       network by network users, the network having a plurality of  
11       internal IP addresses and access to a plurality of external IP  
12       addresses over the Internet, the method comprising the steps of:
- 13       (a) detecting data packets having a source and destination IP  
14       address moving over the network;
  - 15       (b) classifying the detected data packets based on the source  
16       and destination address;
  - 17       (c) assigning the classified data packets to a network user;
  - 18       (d) costing the classified data packets based on a predetermined  
19       costing scheme; and
  - 20       (e) accumulating and storing the costed data packets based on  
21       the assigned user.

22       This appeal arises from the Examiner's final Rejection, mailed April 19,  
23 2006. The Appellant filed an Appeal Brief in support of the appeal on  
24 December 28, 2006. An Examiner's Answer to the Appeal Brief was mailed  
25 on May 3, 2007. A Reply Brief was filed on July 2, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Saari	US 6,338,046 B1	Jan. 8, 2002
Schweitzer	US 6,418,467 B1	Jul. 9, 2002

REJECTIONS

Claims 1-4 and 6 stand rejected under 35 U.S.C. § 102(e) as anticipated by Saari.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Saari and Schweitzer.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Saari.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1-4 and 6 under 35 U.S.C. § 102(e) as anticipated by Saari.
- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claim 5 under 35 U.S.C. § 103(a) as unpatentable over Saari and Schweitzer.
- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103(a) as unpatentable over Saari.

1 The pertinent issue turns on whether the packets in Saari are classified  
2 based on the source and destination address.

3 FACTS PERTINENT TO THE ISSUES

4 The following enumerated Findings of Fact (FF) are believed to be  
5 supported by a preponderance of the evidence.

6 *Facts Related to Claim Construction*

7 01. The disclosure contains no lexicographic definition of  
8 “classify.”

9 02. The ordinary and customary meaning of “classify” is to arrange  
10 or organize according to class or category.<sup>1</sup>

11 *Facts Related to Appellant’s Disclosure*

12 03. The Specification describes classifying user pairs (Specification  
13 4:28 – 5:8).

14 04. The Specification describes Data Accounting classification as  
15 determining which of four equivalent source-to-destination  
16 conditions exist for the point-to-point data packet transfers  
17 (Specification 7:13-15 and 9:4-13).

18 05. The Specification describes filtering as being used for  
19 disregarding unwanted information (Specification 7:5-6).

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<sup>1</sup> *American Heritage Dictionary of the English Language* (4<sup>th</sup> ed. 2000).

1       *Saari*

2           06. Saari is directed to determining charges for usage of network  
3           resources. At the time a connection is established with a network  
4           node, a billing message or cell is transmitted to the node over the  
5           connection. The billing cell contains billing and connection  
6           information which is copied by the node and used to produce  
7           billing information. Information cells are transmitted over the  
8           same connection subsequent to the transmission of the billing cell  
9           (Saari 2:1-12).

10          07. Saari's nodes also transmit their respective charging  
11          information to a common network billing system which generates-  
12          the total charge in a final bill that is forwarded to the user (Saari  
13          2:27-30).

14          08. Saari describes a list of factors that might be used in charging  
15          formulae as including, but not limited to, service class type,  
16          quality of service, any individual or combination of ATM traffic  
17          parameters, connection time, and other traffic flow parameters  
18          (Saari 4:31-33).

19          09. Saari describes how information identifying each node that  
20          processes the information carried by a billing cell may be encoded  
21          in the billing cell as the billing cell travels through the various  
22          connections between the source and destination. As such, the  
23          billing cell may be used as a means of tracking the actual route of  
24          the data as it passes through the network from one location to  
25          another (Saari 6:40-47).

1       *Schweitzer*

2           10. Schweitzer is directed to a network accounting and billing  
3           system (Schweitzer 2:19-20).

4           11. Schweitzer describes filtering as meaning discarding any record  
5           that belongs to a group of unneeded data records (Schweitzer  
6           7:13-14).

7           12. Schweitzer describes how real-time, policy-based filtering and  
8           aggregation can be done. The process then performs data merges  
9           to remove redundant data. The billing record information can be  
10          accessed from external applications. Filtering and/aggregation  
11          and/or data enhancements can be done at any stage in the system  
12          (Schweitzer 10:26-39).

13       *Facts Related To The Level Of Skill In The Art*

14          13. Neither the Examiner nor the Appellant has addressed the level  
15          of ordinary skill in the pertinent arts of systems analysis and  
16          programming, cost accounting, accounting for network usage,  
17          network analysis and programming, and network communications.  
18          We will therefore consider the cited prior art as representative of  
19          the level of ordinary skill in the art. *See Okajima v. Bourdeau*,  
20          261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific  
21          findings on the level of skill in the art does not give rise to  
22          reversible error ‘where the prior art itself reflects an appropriate  
23          level and a need for testimony is not shown’”) (quoting *Litton*

1           *Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163  
2           (Fed. Cir. 1985).

3           14. One of ordinary skill knew that all packets transmitted using the  
4           internet protocol (IP) had the source and destination embedded in  
5           packet header data for the purpose of aggregating the packets back  
6           into the original message the packets were derived from.

7           *Facts Related To Secondary Considerations*

8           15. There is no evidence on record of secondary considerations of  
9           non-obviousness for our consideration.

10                           PRINCIPLES OF LAW

11           *Claim Construction*

12           During examination of a patent application, pending claims are  
13           given their broadest reasonable construction consistent with the  
14           specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In*  
15           *re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

16           Limitations appearing in the specification but not recited in the claim are  
17           not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364,  
18           1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the  
19           specification” without importing limitations from the specification into the  
20           claims unnecessarily).

21           Although a patent applicant is entitled to be his or her own lexicographer  
22           of patent claim terms, in *ex parte* prosecution it must be within limits. *In re*  
23           *Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing  
24           such definitions in the Specification with sufficient clarity to provide a



1 person of ordinary skill in the art with clear and precise notice of the  
2 meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480  
3 (Fed. Cir. 1994) (although an inventor is free to define the specific terms  
4 used to describe the invention, this must be done with reasonable clarity,  
5 deliberateness, and precision; where an inventor chooses to give terms  
6 uncommon meanings, the inventor must set out any uncommon definition in  
7 some manner within the patent disclosure so as to give one of ordinary skill  
8 in the art notice of the change).

#### 9 *Anticipation*

10 "A claim is anticipated only if each and every element as set forth in the  
11 claim is found, either expressly or inherently described, in a single prior art  
12 reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,  
13 631 (Fed. Cir. 1987). "When a claim covers several structures or  
14 compositions, either generically or as alternatives, the claim is deemed  
15 anticipated if any of the structures or compositions within the scope of the  
16 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.  
17 Cir. 2001). "The identical invention must be shown in as complete detail as  
18 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d  
19 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by  
20 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology  
21 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

#### 22 *Obviousness*

23  
24 A claimed invention is unpatentable if the differences between it and  
25 the prior art are "such that the subject matter as a whole would have been  
26 obvious at the time the invention was made to a person having ordinary skill

1 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct.  
2 1727 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

3 In *Graham*, the Court held that that the obviousness analysis is  
4 bottomed on several basic factual inquiries: “[(1)] the scope and content of  
5 the prior art are to be determined; [(2)] differences between the prior art and  
6 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill  
7 in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex*  
8 *Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to  
9 known methods is likely to be obvious when it does no more than yield  
10 predictable results.” *KSR*, at 1739.

11 “When a work is available in one field of endeavor, design incentives  
12 and other market forces can prompt variations of it, either in the same field  
13 or a different one. If a person of ordinary skill can implement a predictable  
14 variation, § 103 likely bars its patentability.” *Id.* at 1740.

15 “For the same reason, if a technique has been used to improve one  
16 device, and a person of ordinary skill in the art would recognize that it would  
17 improve similar devices in the same way, using the technique is obvious  
18 unless its actual application is beyond his or her skill.” *Id.*

19 “Under the correct analysis, any need or problem known in the field  
20 of endeavor at the time of invention and addressed by the patent can provide  
21 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

ANALYSIS

*Claims 1-4 and 6 rejected under 35 U.S.C. § 102(e) as anticipated by Saari.*

The Appellant argues that the dependent claims are patentable for the same reasons as independent claim 1 (Appeal Br. 8) and accordingly we treat these claims as a group.

Accordingly, we select claim 1 as representative of the group.  
37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Saari anticipated claim 1 (Answer 3-4). The Appellant contends that Saari fails to describe elements (b) classifying the detected data packets based on the source and destination address (Appeal Br. 4-7); and (c) assigning the classified data packets to a network user (Appeal Br. 7-8).

In particular, regarding limitation (b), the Appellant contends that Saari does not teach charging strategies, does not enable one of ordinary skill to manipulate billing cell information, classifying source and destination IP addresses and that the Appellant's invention charges a user based solely on the source and destination IP address (Appeal Br. 5).

We disagree with the Appellant. As to whether Saari describes charging strategies, we find that the argument is not commensurate with the scope of the claim. Claim 1 only requires a predetermined costing scheme (Claim 1(d)). Saari's billing cell contains billing and connection information which is copied by a node and used to produce billing information (FF 06). Such a scheme, by virtue of being so laid out, is predetermined and meets limitation (d) of claim 1.

1 As to enablement of billing cell manipulation, Saari itself is indicative of  
2 the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d  
3 1350, 1355 (Fed. Cir. 2001) (FF 13). Thus, we find that the implementation  
4 details, such as data packet parsing, not explicitly described by Saari were  
5 within the knowledge of one of ordinary skill, and Saari was accordingly  
6 enabled as to such implementation detail knowledge.

7 As to classifying source and destinations, we first must construe the term  
8 “classify” which is not lexicographically defined in the Specification (FF  
9 01). The Specification describes two species of the genus classify, *viz.* user  
10 classification and data accounting classification, but does not define the  
11 genus (FF 03 & 04). Claim 1 does not recite either of these species, but  
12 claim 1 instead broadly claims the genus which contains these two species.  
13 The usual and customary meaning of classify is to arrange or organize  
14 according to class or category (FF 02).

15 Saari explicitly describes how information identifying each node that  
16 processes the information carried by a billing cell may be encoded in the  
17 billing cell as the billing cell travels through the various connections  
18 between the source and destination (FF 09). This is an extension of what  
19 one of ordinary skill knew occurred in every packet, i.e. that all packets  
20 transmitted using the internet protocol (IP) had the source and destination  
21 embedded in packet header data for the purpose of aggregating the packets  
22 back into the original message the packets were derived from (FF 14).

23 Thus, the destination necessarily arranges or organizes packets according  
24 to class or category defined by the combination of source and destination to  
25 reconstruct the original message. Thus, element (b) simply recites what

1 every destination machine must do to reconstruct a message passed over the  
2 Internet.

3 The final contention is that the Appellant's invention charges a user  
4 based solely on the source and destination IP address. We find this  
5 argument is not commensurate with the scope of the claim. Claim 1 requires  
6 nothing more of the costing scheme than that it be predetermined. There is  
7 no linkage in claim 1 between the classification based on source and  
8 destination and the costing performed.

9 As to the Appellant's contention regarding element (c), we find that  
10 Saari explicitly transmits charging information to a common network billing  
11 system which generates-the total charge in a final bill that is forwarded to  
12 the user (FF 07). Since the charges for the transmission are assigned to the  
13 user, it necessarily follows that the traffic billed to that user, including the  
14 classified data packets within that traffic, are assigned to the same user to  
15 achieve that billing. As with costing, claim 1 does not require that the  
16 classification be the basis for the assignment. Claim 1 requires only that,  
17 having been classified, packets are assigned to a user.

18 The Appellant has not sustained its burden of showing that the Examiner  
19 erred in rejecting claims 1-4 and 6 under 35 U.S.C. § 102(e) as anticipated  
20 by Saari. Our reasoning differs from that of the Examiner in having relied  
21 on the knowledge of one of ordinary skill regarding how IP packets are  
22 classified. Therefore we treat this rejection as a new ground pursuant to  
23 37 C.F.R. § 41.50(b).

*Claim 5 rejected under 35 U.S.C. § 103(a) as unpatentable over Saari and  
Schweitzer.*

3 The Appellant argues claim 5, requiring a filtering process to exclude  
4 certain predetermined data packets from the costing step. The Examiner  
5 found that this was described by Schweitzer (Answer 5-6). The Appellant  
6 argues that merging is not filtration because all of the records of the larger  
7 file remain after merging (Appeal Br. 9). We disagree. Schweitzer  
8 describes both merging and filtering as being used to discard unwanted data  
9 (FF 11 & 12). The Appellant's disclosure describes filtering as being used  
10 for disregarding unwanted information (FF 05). Thus, Saari's description of  
11 merging and filtration are each consistent with the meaning of filtering  
12 disclosed by the Appellant.

13       The Appellant has not sustained its burden of showing that the Examiner  
14       erred in rejecting claim 5 under 35 U.S.C. § 103(a) as unpatentable over  
15       Saari and Schweitzer. This claim depends from claim 1, in which our  
16       reasoning differs from that of the Examiner in having relied on the  
17       knowledge of one of ordinary skill regarding how IP packets are classified.  
18       Therefore we treat this rejection as a new ground pursuant to 37 C.F.R.  
19       § 41.50(b).

20 *Claim 7 rejected under 35 U.S.C. § 103(a) as unpatentable over Saari.*

21 The Appellant argues independent claim 7, requiring a programmable  
22 device that contains both a network controller and a processor that classifies  
23 and costs data packets. The Examiner found that this was known to one of  
24 ordinary skill as the mechanism encapsulating Saari's system (Answer 6).  
25 The Appellant argues that the Examiner has shown no reason to modify

1 Saari for this because there is no reason to include a network controller and  
2 cost processor in a single device (Appeal Br. 12). The Appellant also argues  
3 claim 7 is patentable for the same reasons as claim 1.

4 We disagree with the Appellant. Any computer is a programmable  
5 device. The Appellant is arguing no more than that it would not be obvious  
6 to provide two functions that produce predictable results in a common  
7 computer. “The combination of familiar elements according to known  
8 methods is likely to be obvious when it does no more than yield predictable  
9 results.” *KSR*, 127 S. Ct. at 1739. A combination of a network controller  
10 and a cost processor produces the expected results of each of the  
11 components in a single device. We find the arguments applied in support of  
12 claim 1 to be equally unpersuasive toward claim 7 for the same reasons we  
13 found *supra*.

14 The Appellant has not sustained its burden of showing that the Examiner  
15 erred in rejecting claim 7 under 35 U.S.C. § 103(a) as unpatentable over  
16 Saari. The Appellant’s arguments for this claim include arguments made for  
17 claim 1. To that extent, our reasoning differs from that of the Examiner in  
18 having relied on the knowledge of one of ordinary skill regarding how IP  
19 packets are classified. Therefore we treat this rejection as a new ground  
20 pursuant to 37 C.F.R. § 41.50(b).

CONCLUSIONS OF LAW

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 1-4 and 6 under 35 U.S.C. § 102 as anticipated by Saari, and claims 5 and 7 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

The rejections of claims 1-7 are denominated as new grounds of rejection pursuant to 37 C.F.R. § 41.50(b).

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-4 and 6 under 35 U.S.C. § 102(e) as anticipated by Saari is sustained.
- The rejection of claim 5 under 35 U.S.C. § 103(a) as unpatentable over Saari and Schweitzer is sustained.
- The rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over Saari is sustained.
- The rejections of claims 1-7 are denominated as new grounds of rejection pursuant to 37 C.F.R. § 41.50(b).

Our decision is not a final agency action.

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains new grounds of rejection pursuant to 37 CFR



1    § 41.50(b). 37 CFR § 41.50(b) provides “[a] new ground of rejection  
2    pursuant to this paragraph shall not be considered final for judicial review.”

3            37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO  
4    MONTHS FROM THE DATE OF THE DECISION, must exercise one of  
5    the following two options with respect to the new rejection:

6            (1) Reopen prosecution. Submit an appropriate amendment of  
7            the claims so rejected or new evidence relating to the claims  
8            so rejected, or both, and have the matter reconsidered by the  
9            Examiner, in which event the proceeding will be remanded  
10          to the Examiner. . . .

11          (2) Request rehearing. Request that the proceeding be reheard  
12          under § 41.52 by the Board upon the same record. . . .

13          Should the Appellants elect to prosecute further before the examiner  
14    pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek  
15    review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection,  
16    the effective date of the affirmance is deferred until conclusion of the  
17    prosecution before the examiner unless, as a mere incident to the limited  
18    prosecution, the affirmed rejection is overcome.

19          If the appellant elects prosecution before the examiner and this does  
20    not result in allowance of the application, abandonment or a second appeal,  
21    this case should be returned to the Board of Patent Appeals and Interferences  
22    for final action on the affirmed rejection, including any timely request for  
23    rehearing thereof.

24

